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09/613,339	07/10/2000	Nobuyoshi Morimoto	5596-00300	9759

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ROBERT C KOWERT
MEYERTONS HOOD KIVIN KOWERT & GOETZEL PC
P O BOX 398
AUSTIN, TX 78767-0398

EXAMINER

ELISCA, PIERRE E

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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/613,339
Filing Date: July 10, 2000
Appellant(s): MORIMOTO, NOBUYOSHI

Robert C. Kowert

For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the order by the Board of Patent Appeals and Interferences dated 3/26/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0029188 A1

Schmid 12/1999 Provisional

6,285,986

Andrews 09/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-44 are pending.

Claim Rejections - 35 USC § 101

Claims 1-13 and 29- 44 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. Applicant is advised to add a machine or computer into the body of the claims.

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

In this particular case, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. As noted below, a 'process' is not a machine. Additionally, the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-7, 9-31, 32-35 and 37-44 are rejected under 35 U.S.C. 102 (e) as being anticipated by **Schmid US 2002/0029188 A1 with a non-provisional of provisional application No. 60/172,736, filed on 12/20/1999.**

As per claims 1, 3-7, 9-31, 32-35 and 37-44 Schmid (60/172,736 provisional application) discloses a computerized system for negotiating loans on behalf of a borrower collects data on a desired loan transaction in electronic form. The system electronically notifies a plurality of lenders of the requested loan transaction and invites each lender to electronically submit a corresponding quote. Each lender is also provided with options to improve their corresponding quote (which is readable as Applicant's

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claimed invention wherein it is stated that a method for negotiating improved terms for a product or service), comprising:

Detecting an issuance of a commitment to purchase with associated terms for said product or service being purchased by a purchaser using an Internet web site, in response to said detecting, making an offer to said purchaser to accept or reject a contract for negotiating said improved terms within a specified time, if said purchaser accepts said offer, conducting a search for said improved terms (specifically wherein said each lender is also provided with options to improve their corresponding quote, abstract) within said specified time, receiving said improved terms within said specified time, and executing said contract (see., abstract, page 1, [0008], [0014], page 2, [0017], page 3, [0024]-[0031]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 8, 31 and 36 are rejected under 35 U.S.C 103 (a) as being unpatentable over Schmid (**60/172,736**) in view of Andrews (U.S. Pat. No. 6,285,986).

As per claims 2, 8, 31 and 36 Schmid (**60/172,736 provisional application**) discloses the claimed method as stated in claim 1 above. Schmid fails to explicitly disclose the step of detecting comprises detecting said purchaser entering a credit card

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number or a pre-paid account number or a gift certificate number. However, Andrews discloses a method of payment and shipping information (see., col 2, lines 37-48).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Schmid by including the limitation detailed above as taught by Andrews since the form of payment information can also include payment by credit card or gift certificate or account number.

NOTE

LENDINGTREE.com is not a reference and I am just using the provisional to provide support.

Appeal Conference

NO.	Claim 1	Schmid US 2002/0029188/ 60/172736	Andrews 6,285,986
1	Claim 1 recites a method of negotiating improved terms for a product or service. Associated terms for said product. Improved term=borrower selects quote and best terms. Specified time= a period of negotiation, the borrower selects	Negotiating loans on behalf of a borrower, see., abstract, page 1, [0008]. See., [0008], [0014]. See., page 1, [0003] OR provisional	

	<p>one quote.</p> <p>Conducting a search=company's manpower, i.e borrower may call on three, four, five or more lending sources</p>	<p>application</p> <p>60/172,736, pages 1-15, fig 1A.</p>	
2	Claims 2, 8, 31 and 36 (103)	<p>Schmid fails to disclose a method of entering a credit card number or pre-paid account number or a payment.</p>	<p>Andrew discloses a method of payment and shipping information (col 2, lines 37-48).</p>
	<p>Claim 14 recites a commitment to purchase=when the lending source issues a commitment letter to fund the loan (see., [0005]).</p> <p>Claims 5 and 6 recite displaying (or clicking an icon) said contract on a screen of a computer= the system displays the selected quotes to the borrower and also to each lender (see., page 1, [0008])</p>	<p>Web site</p> <p>server=company web site see., abstract.</p> <p>see., page 1, [0008].</p> <p>Notification about issuance of purchase=the system notifies</p>	

	and [0017]. Claims 29, 41 and 44 recite detecting an alternative contract=borrower may negotiate one lending against another to improve his/her position for better price or quote (see., [0004] and [0008].	multiple lenders... OR provisional application 60/172,736, pages 1-15, fig 1A.	
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(10) Response to Argument

In response to Applicant's representative's arguments, Applicant's representative argues that:

- a. The December 20, 1999 filing date can only be used as Schmid's 35 U.S.C. 102 (e) prior art date for the subject matter that is common to both the Schmid patent and the provisional application. **As described above, the provisional application (60/172,736) supports and enables the subject matter in Schmid that the Examiner relied upon in making the rejection. Schmid is entitled to the benefit of the filing date of the provisional application under 35 USC 119 (e), that Schmid is properly available as prior art under 35 USC 102 (e). See In re Wertheim, 646 F2d 527 (CCPA 1981). See MPEP 2136.03.**
- b. Regarding claims 1, 3, 7, 10, 15, 16, 20, 23, 29 and 38-40, Applicant's representative argues that Schmid fails to disclose detecting an issuance of a

commitment to purchase with associated terms for a product. As indicated above, the **Schmid provisional application 60/172,736 discloses this limitation in pages 1-15**, specifically page 3, wherein said when the lending source issues a commitment letter to fund the loan.

Please note that original purchase as recited in claim 29 is interpreted as a regular purchase.

c. Schmid fails to disclose conducting a search for the improved terms within the specified time. The Examiner respectfully disagrees with this assertion because Schmid discloses this limitation in page 2, specifically wherein said company's manpower, i.e borrower may call on three, four, five or more lending sources.

d. In regard to claim 16, Applicant's representative argues that the Schmid provisional application fails to disclose detecting the purchaser viewing a particular web page. As noted above, Schmid discloses this limitation in page 1 and pages 5-8, specifically wherein said if more than one deal were pending with prospective borrower or client, specifics about each deal would be viewable. Please note that this process is performed via commercialFunding.com web site, and therefore commercialFundind is capable of detecting or tracking the purchaser viewing a particular web page, and also page 7 for specific deal tracking.

e. In regard to claims 5 and 17, Applicant's representative argues that Schmid fails to disclose detecting said purchaser clicking an icon to confirm order. The Examiner respectfully disagrees with this assertion since Schmid discloses this limitation in pages 3 and 7.

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In regard to claim 6 and 19, Schmid fails to disclose making an offer to the purchaser includes displaying the contract of a computer system. This limitation is disclosed by Schmid in pages 1, specifically wherein said the invention is viewable on computer monitors in the form of a web site, and also page 7 for viewing deal contract.

f. In regard to claims 9, 12, 22 and 25 Schmid fails to disclose improved terms comprise a better price. However, this limitation is also disclosed by Schmid in page 3, specifically wherein said borrower may negotiate one lending against another to improve his/her position for better price or quote.

g. Regarding claim 1 and its dependent claims, note that "if" is analogous to "may", and therefore optional elements do not narrow the claim because they can always be omitted. *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the federal Circuit affirmed the Board's claim construction of "further including that said wall **may** be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased" since "this additional content did not narrow the scope of the claim because these limitations are stated in the permission form "may"). Because the purchaser has the option of **not** accepting the offer, the use of "if" in e.g. claim 1 (i.e. "if said purchaser accepts said offer) is analogous to "may" in *Johnston*. Like *Johnston*, the additional method steps ("conducting ... receiving ... and excuting") do not narrow the scope of the claim because these methods steps stated in the permission form "if."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Pierre Eddy Elisca/
Primary Examiner

Conferees:

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694

/C.L.H./
Hewitt Calvin II
Supervisory Patent Examiner, Art Unit 3685

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/
Director, TC 3600